

## **REMARKS**

### Office action summary

As of the mailing of the office action of December 21, 2010, claims 40-41, 43-53, 55-65, 67, 71, and 73-78 were pending in the present application. Claims 40, 43, 52, 55, 64, and 73 are presently amended. Claims 45-46, 57-58, and 74-75 are presently canceled. Claims 79-81 are presently added. Thus, following entry of the present amendments, claims 40-41, 43-44, 47-53, 55-56, 59-65, 67, 71, 73, and 76-81 will be pending.

In the Office Action, the examiner rejected the claims and deemed the claims to be allowable as follows:

- Claims 40-41, 43-53, 55-65, 67, 71, and 73-78 were rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement.
- Claims 64-65, 67, 71, 73-75, and 78 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention.
- Claims 40-41, 48-51, 52-53, 60-65, 67, and 71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser, US Patent 7,263,497 (“Wiser”), in view of Hamada, US Patent 6,792,007 (“Hamada”).
- Claims 43, 55, and 73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser in view of Hamada, and further in view of Williams, “MP3 All in One,” Newsbytes, July 23, 1999 (“Williams”).
- Claims 44 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser, in view of Hamada, in view of Williams, and further in view of Wolff, US Patent 6,247,047 (“Wolff”).
- Claims 47 and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser, in view of Hamada, in view of Williams, and further in view of Allen, US Publication 2003/0036974 (“Allen”).

- Claims 76-78 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wisner, in view of Hamada, and further in view of Doyle, US Patent 5,694,551 (“Doyle”).
- Claims 45-46, 57-58, and 74-75 were deemed to be allowable if (1) rewritten in independent form including all the limitations of their base claims and any intervening claims, and (2) the rejections under 35 U.S.C. § 112 were overcome.

The amendments and rejections are discussed below. The examiner is respectfully urged to reconsider the application and withdraw the rejections. Should the examiner have any questions or concerns that might be efficiently resolved by way of a telephonic interview, the examiner is invited to call applicants’ undersigned attorney, Jon M. Isaacson, at **206-332-1102**.

#### Telephonic interview

On February 7, 2011, applicants’ undersigned attorney and Examiner Allen conducted a telephonic interview. Applicants’ undersigned attorney would like to thank the examiner for granting the interview. During the interview, the claims and the rejections were discussed. Any further substance of the interview is incorporated into the remarks below.

#### Rejections of canceled claims

**Claims 45-46, 57-58, and 74-75** each stood rejection under 35 U.S.C. §§ 103(a) and 112. Without conceding the propriety of any of the rejections of claims 43, 45-46, 55, 57-58, and 73-75, in an effort to advance prosecution of the present application, applicants presently cancel claims 43, 45-46, 55, 57-58, and 73-75. Accordingly applicants submit that the rejections of claims 43, 45-46, 55, 57-58, and 73-75 under 35 U.S.C. §§ 103(a) and 112 are moot.

#### Rejections under 35 U.S.C. § 112, ¶ 1

**Claim 40** stands rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement. More specifically, the examiner finds that “although the specification is supportive of storing a music selection in intermediate storage and sometime thereafter permanently storing the music selection, nowhere in Applicant’s specification is there

support for recording *from* the intermediate storage *to* permanent storage.” Office Action, page 8 (emphasis in original). From this, the examiner concludes that the specification does not provide support for “receiving an indication that at least a portion of the music selection has been recorded from the intermediate storage medium to a permanent storage medium located at the consumer site,” as recited by claim 40. Applicants persist in their assertion that this portion of claim 40 is supported by the specification for at least those reasons discussed on pages 14-16 of applicants’ remarks filed on November 22, 2010. However, without conceding the propriety of the examiner’s findings in the Office Action, in an effort to advance prosecution of the present application, applicants presently amend claim 40 to recite “receiving an indication that at least a portion of the music selection has been recorded on the intermediate storage medium and subsequently recorded on a permanent storage medium located at the consumer site.” The examiner indicates that the specification supports storing a music selection in intermediate storage and sometime thereafter permanently storing the music selection and the examiner used a similar interpretation for purposes of examining claim 40. Office Action, page 8. Thus, applicants submit that claim 40, as presently amended, is supported by the specification. Accordingly, applicants respectfully request withdrawal of the rejection of claim 40 under 35 U.S.C. § 112, ¶ 1.

**Claims 52 and 64** stand rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement for essentially the same reasons that claim 40 was deemed not to comply with the written description requirement. Office Action, page 8. Without conceding the propriety of the rejection of claims 52 and 64, applicants presently amend claims 52 and 64 to recite subject matter similar to the subject matter recited by claim 40. For at least the reasons that claim 40 is supported by the specification, applicants submit that claims 52 and 64 are supported by the specification. Accordingly, applicants request withdrawal of the rejection of claims 52 and 64 under 35 U.S.C. § 112, ¶ 1.

**Claims 41, 43-44, 47-51, 53, 55-56, 59-63, 65, 67, 71, 73, and 75-78** stand rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement. Claims 41, 43-44, 47-51, 53, 55-56, 59-63, 65, 67, 71, 73, and 75-78 depend from claims 40, 52,

and 64, and were rejected under 35 U.S.C. § 112, ¶ 1, because of their dependency from claims 40, 52, and 64. Inasmuch as claims 40, 52, and 64 are supported by the specification, applicants submit that dependent claims 41, 43-44, 47-51, 53, 55-56, 59-63, 65, 67, 71, 73, and 75-78 are also supported by the specification. Accordingly, applicants request withdrawal of the rejection of claims 41, 43-44, 47-51, 53, 55-56, 59-63, 65, 67, 71, 73, and 75-78 under 35 U.S.C. § 112, ¶ 1.

**Claim 64** further stands rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement as reciting means-plus-function language which does not have any corresponding structure, material, or acts in the specification. Office Action, page 9. More specifically, the examiner found that the term “means for receiving an indication that at least a portion...” invokes 35 U.S.C. § 112, ¶ 6, but the examiner indicated that the specification did not contain any corresponding structure, material, or acts. Office Action, page 9. The examiner further indicated that the rejection could be overcome by amending the claim so that this recitation is no longer a means plus function recitation. Office Action, pages 9-10.

Without conceding the propriety of the rejection of claim 64 under 35 U.S.C. § 112, ¶ 1, in an effort to advance prosecution of the present application, applicants presently amend claim 64. As amended, claim 64 recites “a central controller system configured to...receive an indication that at least a portion...” Applicants submit that this recitation is supported by the specification at least by page 15, lines 8-16, and Figures 1, 3, and 4. Inasmuch as claim 64 has been amended such that the recited “central controller system configured to...receive an indication” does not invoke 35 U.S.C. § 112, ¶ 6, and inasmuch as this recitation is supported by the specification, applicants respectfully request withdrawal of the rejection of claim 64 under 35 U.S.C. § 112, ¶ 1.

**Claims 65, 67, 71, 73, and 78** further stand rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the written description requirement because they depended from claim 64. Office Action, page 9. Claims 65, 67, 71, and 78 depend from claim 64. Inasmuch as claim 64 is supported by the specification, applicants submit that dependent claims 65, 67, 71, and 78 are

also supported by the specification. Accordingly, applicants request withdrawal of the rejection of claims 65, 67, 71, 73, and 78 under 35 U.S.C. § 112, ¶ 1.

Rejections under 35 U.S.C. § 112, ¶ 2

**Claim 64** stands rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. More specifically, the examiner found that “the written description fails to clearly link or associate the disclosed structure, materials, or acts to the claimed function” in both of the “means for receiving an indication” and “means for automatically charging” recited by claim 64. Office Action, page 11. Without conceding the propriety of the rejection of claim 64 under 35 U.S.C. § 112, ¶ 2, in an effort to advance prosecution of the present application, applicants presently amend claim 64. As amended, claim 64 recites “a central controller system configured to...receive an indication...and automatically charge the consumer.” Applicants submit that this recitation is not indefinite, especially when read in light of page 15, lines 8-16, and Figures 1, 3, and 4 of the specification. Inasmuch as this recitation of claim 64 is not indefinite, applicants respectfully request withdrawal of the rejection of claim 64 under 35 U.S.C. § 112, ¶ 2.

**Claims 65, 67, 71, 73, and 78** stand rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention because they depended from claim 64 which was deemed to be indefinite. Office Action, page 12. Inasmuch as claim 64 is not indefinite, applicants submit that dependent claims 65, 67, 71, 73, and 78 are also not indefinite. Accordingly, applicants request withdrawal of the rejection of claims 65, 67, 71, 73, and 78 under 35 U.S.C. § 112, ¶ 2.

Rejections under 35 U.S.C. § 103(a)

**Claim 40** stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser in view of Hamada. Without conceding the propriety of the rejection of claim 40, in an effort to advance prosecution of the present application, applicants presently amend claim 40. As amended, claim 40 recites subject matter which is similar to the subject matter previously recited

by claims 45 and 46. Claims 45 and 46 depended from claim 43, and claim 40, as presently amended, also recites a portion of the subject matter previously recited by claim 43. In the Office Action, the examiner indicates that claims 45 and 46 would be allowable if rewritten in independent form including all the limitations of their base claims and any intervening claims. As presently amended, claim 40 recites subject matter which is similar to the subject matter previously recited by claims 45 and 46, including all of the limitations of their base claim and the relevant portions of intervening claim 43. Thus, for at least the reasons that claims 45 and 46 were deemed to be allowable if rewritten in independent form, applicants submit that claim 40 is not rendered obvious by the cited references. Accordingly, applicants respectfully request withdrawal of the rejection of claim 40 under 35 U.S.C. § 103(a).

**Claim 52** stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser in view of Hamada. Without conceding the propriety of the rejection of claim 52, in an effort to advance prosecution of the present application, applicants presently amend claim 52. As amended, claim 52 recites subject matter which is similar to the subject matter previously recited by claims 57 and 58. Claims 57 and 58 depended from claim 55, and claim 52, as presently amended, also recites a portion of the subject matter previously recited by claim 55. In the Office Action, the examiner indicates that claims 57 and 58 would be allowable if rewritten in independent form including all the limitations of their base claims and any intervening claims. As presently amended, claim 52 recites subject matter which is similar to the subject matter previously recited by claims 57 and 58, including all of the limitations of their base claim and the relevant portions of intervening claim 55. Thus, for at least the reasons that claims 57 and 58 were deemed to be allowable if rewritten in independent form, applicants submit that claim 52 is not rendered obvious by the cited references. Accordingly, applicants respectfully request withdrawal of the rejection of claim 52 under 35 U.S.C. § 103(a).

**Claim 64** stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser in view of Hamada. Without conceding the propriety of the rejection of claim 64, in an effort to advance prosecution of the present application, applicants presently amend claim 64. As amended, claim 64 recites subject matter which is similar to the subject matter previously recited

by claims 74 and 75. Claims 74 and 75 depended from claim 73, and claim 64, as presently amended, also recites a portion of the subject matter previously recited by claim 73. In the Office Action, the examiner indicates that claims 74 and 75 would be allowable if rewritten in independent form including all the limitations of their base claims and any intervening claims. As presently amended, claim 64 recites subject matter which is similar to the subject matter previously recited by claims 74 and 75, including all of the limitations of their base claim and the relevant portions of intervening claim 73. Thus, for at least the reasons that claims 74 and 75 were deemed to be allowable if rewritten in independent form, applicants submit that claim 64 is not rendered obvious by the cited references. Accordingly, applicants respectfully request withdrawal of the rejection of claim 64 under 35 U.S.C. § 103(a).

**Claims 41, 48-51, 53, 60-63, 65, 67, and 71** stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiser in view of Hamada. Claims 41, 48-51, 53, 60-63, 65, 67, and 71 depend from claims 40, 52, and 64. Inasmuch as claims 41, 48-51, 53, 60-63, 65, 67, and 71 depend from claims which are not rendered obvious by Wiser and Hamada, applicants submit that claims 41, 48-51, 53, 60-63, 65, 67, and 71 are also not rendered obvious by Wiser and Hamada. Accordingly, applicants respectfully request withdrawal of the rejection of claims 41, 48-51, 53, 60-63, 65, 67, and 71 under 35 U.S.C. § 103(a).

**Claims 43-44, 47, 55-56, 59, 73, and 76-78** stand under 35 U.S.C. § 103(a) as being unpatentable over Wiser in view of Hamada, and further in view of one or more of Williams, Wolff, Allen, and Doyle. Claims 43-44, 47, 55-56, 59, 73, and 76-78 depend from claims 40, 52, and 64. Inasmuch as claims 43-44, 47, 55-56, 59, 73, and 76-78 depend from claims which are not rendered obvious by the cited references, applicants submit that claims 43-44, 47, 55-56, 59, 73, and 76-78 are also not rendered obvious by the cited references. Accordingly, applicants respectfully request withdrawal of the rejection of claims 43-44, 47, 55-56, 59, 73, and 76-78 under 35 U.S.C. § 103(a).

**DOCKET NO.:** \*\*OO-0145  
**Application No.:** 09/707,273  
**Office Action Dated:** December 21, 2010

**PATENT**

New claims

Claim 79-81 are presently added. Claims 79-81 depend from claims 40, 52, and 64. Inasmuch as claims 79-81 depend from claims which are not rendered obvious by the cited references, applicant submit that claims 79-81 are also not rendered obvious by the cited references. Accordingly, applicants submit that claims 79-81 are in condition for allowance.

Conclusion

Applicants believe that the present remarks are responsive to each of the points raised by the examiner in the Office Action, and submit that claims 40-41, 43-44, 47-53, 55-56, 59-65, 67, 71, 73, and 76-81 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the examiner's earliest convenience is earnestly solicited.

Date: February 17, 2011

/Jon M. Isaacson/  
Jon M. Isaacson  
Registration No. 60,436

Woodcock Washburn LLP  
Cira Centre  
2929 Arch Street, 12th Floor  
Philadelphia, PA 19104-2891  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439